

WW  
DAC

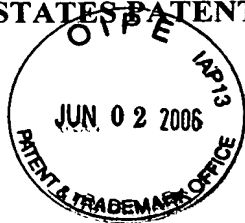
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Martin HEENEY et al.

Serial No.: 10/661,812

Filed: September 15, 2003



Group Art Unit 1711

Examiner: Duc Truong

For: MONO-, OLIGO- AND POLY(3-ALKYNYLTHIOPHENES) AND THEIR USE AS CHARGE TRANSPORT MATERIALS

**PETITION TO COMMISSIONER UNDER 37 C.F.R. §1. 181 FOR WITHDRAWAL OF RESTRICTION REQUIREMENT and FOR MODIFICATION OF THE IMPLEMENTATION OF THE ELECTION OF SPECIES REQUIREMENT**

**MAIL STOP PETITION**

Commissioner for Patents  
Box 1450  
Alexandria, Virginia 22313-1450

SIR:

Applicants hereby petition the Commissioner under 37 C.F.R. §1.181 for withdrawal of the restriction requirement outstanding in this application and for modification of the manner in which the applicants' election pursuant to the Election of Species Requirement was applied.

Points to be Reviewed

- 1) Whether the Restriction Requirement outstanding in this application is proper.
- 2) Whether applicants' election pursuant to the Election of Species requirement was properly applied.



### Statement of Facts

The Restriction Requirement and Election of Species Requirement were both set forth in the Office Action mailed July 8, 2005. Applicants traversed the restriction in their Response filed August 8, 2005, and have maintained their traversal throughout this prosecution. Applicants made a proper election pursuant to the Election of Species requirement in their Response filed August 8, 2005. The Restriction and Election of Species requirements were made Final in the Office Action mailed September 15, 2005. The restriction was originally made between Group I, claims 1-15, drawn to monomers, oligomers or polymers, and Group II, claims 16-27, drawn to polymerizable liquid crystal materials and devices containing such monomers, oligomers or polymers. Applicants elected Group I with traverse in their Response filed August 8, 2005. The Election of Species requirement requested an election from one of the species formulae in claim 14 defining the formula I portion – i.e., the base or building block portion – of the claimed monomer, oligomer or polymer. Applicants elected the species wherein the formula I portion of the monomer, oligomer or polymer was defined by formula Ia of claim 14 in their Response filed August 8, 2005.

### Applicants' Arguments regarding the Restriction Requirement

The original reason given to support the restriction was that the Groups were in a combination/subcombination relationship and that "the combination as claimed does not require the particulars of the subcombination as claimed because the composition of Group I does not require the other component besides said monomer, oligomer or polymer of Group I." Applicants urge that this statement incorrectly treats the monomer, oligomer or polymer of Group I as the combination, whereas, it should be evident that the monomer, oligomer or polymer of Group I is the subcombination which is combined with something else (e.g.,

another polymerizable compound in claim 16) to arrive at the combination of Group II. In other words, the compositions, etc., of claims 16-27 combine the monomer, oligomer, polymer aspect of claims 1-15 with another component to make a composition or device. Thus, the root basis for the restriction is improper.

The restriction does not meet the requirements for restriction in a subcombination/combination circumstance set forth in MPEP §806.05(c) because the combination claims 16-27 do require the particulars of the subcombination monomer, oligomer, or polymer claims 1-15. Each of claims 16-27 depends ultimately from claim 1, thus, by definition as dependent claims, they must require the particulars of claim 1. To put it another way, if claim 1 is allowable, claims 16-27 should also be allowable because they contain an embodiment of claim 1 as a component. Accordingly, since the first prong of the basis for restriction under MPEP §806.05(c) is not met, the restriction requirement herein is not supported. No other basis for restriction was made or is apparent, thus, the requirement should be withdrawn.

The Examiner later alleged that inventions in Groups I and II gave rise to a separate search requirement. But mere separate classification and further search requirement does not support a restriction requirement. As discussed above, applicants' point of traversal is that there is a failure to establish proper restriction in the instant situation where the claims of Group I and Group II are related as subcombination/combination.

For the above reasons, applicants petition for withdrawal of the Restriction Requirement, as a whole.

#### Applicants' Arguments regarding the Election of Species Requirement

In response to the Election of Species requirement, applicants had elected the species wherein formula I was shown by the species of formula Ia of claim 14. The following Office

Action alleged that only claims 1-6, 10, 11 and 14-15 read on the elected species. Applicants urged, however, that claims 9, 12 and 13 also read on this species. The required presence of P-Sp- groups for the compounds in these claims does not remove them from encompassing species wherein formula I is represented by the species of formula Ia of claim 14. Formula Ia of claim 14 does not provide any further requirement for the  $R^1$  group therein and the definition of  $R^1$  in claim 1 includes P-Sp- groups. Further, formula Ia does not require any particulars of the right and left terminal groups ( $R^4$  and  $R^5$  in formula I1, claim 2) and, thus, the formula encompasses monomers, oligomers and polymers wherein such groups can be P-Sp-. In response, the Examiner in the Final Office Action apparently disagreed on the basis that that  $R^4$  and  $R^5$  were allegedly only optionally P-Sp-. Applicants respectfully point out that this statement is not correct and not relevant to whether claims 9, 12 and 13 are within the elected species. First, the allegation is incorrect, since claim 9 requires that one or both of  $R^4$  and  $R^5$  be P-Sp-, thus, a P-Sp- group is not optional. Second, even if the allegation were correct, it has no relation to whether claim 9 is within the elected species because the elected species is defined only by the portion of the monomer, oligomer or polymer that is defined by formula I and not by the groups terminal thereto. Third, the allegation regarding claim 9 has no relation at all to claims 12 and 13.

To expand on the second point, the elected species is the species of formula Ia of claim 14. This species is defined by the nature of the  $-(A)_a-(B)_b-(C)_c-(D)_d-$  group. No requirement was made for an election of species of the  $R^4$  or  $R^5$  group. Thus, whether or not the  $R^4$  and  $R^5$  groups are P-Sp- has no bearing on whether they are within the elected species. Accordingly, claim 9 encompasses the elected species since it includes species wherein  $-(A)_a-(B)_b-(C)_c-(D)_d-$  is as defined by formula Ia. Similarly, regarding claims 12 and 13, these claims do not exclude species wherein  $-(A)_a-(B)_b-(C)_c-(D)_d-$  is as defined by formula Ia. These claims require species which contain a P-Sp- group somewhere. Although the P-

Sp- group could be in the R<sup>1</sup> or R<sup>2</sup> group, it is not required to be part of such group; for example it can be in the terminal R<sup>4</sup> or R<sup>5</sup> groups. In this latter case, the claims encompass species wherein  $-(A)_a-(B)_b-(C)_c-(D)_d-$  is as defined by formula Ia. Thus, these claims also read on the elected species.


For the above reasons, it is urged that claims 9, 12 and 13 have been improperly treated as withdrawn pursuant to the Election of Species requirement when it is clear that, as applicants have maintained, they read on, i.e., encompass, elected species.

Action Requested

Applicants request withdrawal, in total, of the Restriction Requirement outstanding in this application. Applicants also request that claims 9, 12 and 13 be included as claims that read on the elected species pursuant to the Election of Species requirement.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
\_\_\_\_\_  
John A. Sopp  
Registration No. 33,103  
Attorney for Applicants

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza I  
2200 Clarendon Blvd. Suite 1400  
Arlington, Virginia 22201  
Telephone: (703)243-6333  
Facsimile: (703) 243-6410  
Attorney Docket No.: MERCK-2740

Date: June 2, 2006